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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/840,217

05/07/2004

Shigeyuki Kawai

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RADER FISHMAN & GRAUER PLLC  
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WASHINGTON, DC 20036

EXAMINER

FRANKLIN, JAMARA ALZAIDA

ART UNIT

PAPER NUMBER

2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

5/17

**Office Action Summary**

Application No.

10/840,217

Applicant(s)

KAWAI ET AL.

Examiner

Jamara A. Franklin

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/580,542.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/07/04</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Acknowledgment is made of the preliminary amendment filed on May 07, 2004. Claims 1-32 are currently pending.

#### ***Election/Restrictions***

1. Applicant's election without traverse of claims 1-8 and 11-32 in the reply filed on November 5, 2006 is acknowledged.

#### ***Specification***

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Claim Objections***

3. Claims 1, 4, 7-9, 11, 13, 15, 29, 31, and 32 are objected to because of the following informalities:

in claim 1, line 5, substitute the second occurrence of "the" with --an--;

in claim 1, line 9, substitute "the" with --a--;

in claim 4, line 2, delete the first occurrence of "the";

in claim 7, line 2, substitute "unit" with --money terminal--;

in claim 8, line 2, substitute "unit" with --money terminal--;

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- in claim 9, line 5, substitute the third occurrence of "a" with --the--;
- in claim 9, line 6, substitute the second occurrence of "the" with --an--;
- in claim 11, line 3, substitute "an" with --a portable--;
- in claim 11, line 6, substitute the second occurrence of "the" with --an--;
- in claim 13, line 4, substitute "the" with --a--;
- in claim 15, line 3, delete "the";
- in claim 29, line 14, substitute "the" with --a--;
- in claim 31, line 10, substitute the first occurrence of "the" with --a--; and
- in claim 32, line 9, substitute the first occurrence of "the" with --a--.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 11, 13, 26, and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Although a user account and a designated account is discussed in the specifications, the examiner could find no discussion of an alternative account and elements related to an alternative account (including alternative account reading means, alternative account querying means, and alternative account

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crediting means). Neither the designated account nor the user's account as discussed in the specifications appear to correlate to the alternative account as claimed. For examination purposes, limitations containing the aforementioned will be considered and reviewed.

Appropriate correction or clarification is required.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 20-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,764,001. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and Patent '001 teach:

regarding claim 20, a method for executing cashless transactions, the method comprising:

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providing a portable electronic device having a portable device memory that stores a predetermined cash value (col. 14, lines 38-39);

providing an electronic money terminal having a terminal memory (col. 14, lines 40-41);

bringing the portable electronic device into electronic communication with the electronic money terminal (col. 14, lines 42-43);

deducting value, by the electronic money terminal, that exceeds the predetermined cash value from the portable device memory (col. 14, lines 44-46);

storing a transaction amount that represents the predetermined cash value in the terminal memory (col. 14, lines 47-48);

calculating a balance due that represents a difference between the predetermined cash value and the value (col. 14, lines 49-50); and

storing the balance due in the terminal memory (col. 14, line 51);

regarding claim 21, the method further comprising:

providing an electronic money management system that has a management memory (col. 14, lines 52-53);

uploading the balance due to the electronic money management system (col. 14, lines 54-55); and

storing the balance due in the management memory (col. 14, line 56);

regarding claim 22, the method further comprising:

collecting a plurality of balances due in the terminal memory (col. 14, lines 58-59); and

uploading the plurality of balances due to the electronic money management system during one upload (col. 14, lines 60-61); and

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regarding claim 23, the method further comprising:

sorting each of the plurality of balances due, at the electronic money management system, according to a time zone in which each balance due was transacted (col. 14, lines 62-64);

deducting fees from each balance due based on respective time zones in which each balance due was transacted to generate respective payment amounts (col. 14, lines 65-67); and

dispatching, from the electronic money management system, payment amounts to the electronic money terminal (col. 15, lines 1-3);

regarding claim 24, the method further comprising:

periodically verifying authorization of a credit line for a user bearing the portable electronic device by the electronic money management system (col. 15, lines 27-29);

dispatching an authorization or denial code to the electronic money terminal based on the periodically verifying step (col. 15, lines 30-32);

storing the authorization code or denial code at the electronic money terminal (col. 15, lines 33-34); and

authorizing or denying execution of the balance due based on the authorization code or denial code stored at the electronic money terminal (col. 15, lines 35-37).

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 13-24, 27, and 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Slater et al. (US 4,114,027) (hereinafter referred to as 'Slater').

Slater teaches  
a transaction method which uses electronic money, comprising the steps of:  
subtracting a transaction amount from electronic money contained in a portable electronic device;  
processing a payment of a balance due so that the payment is deferred when the transaction amount exceeds an amount of electronic money contained in the electronic device;  
reading account information for a designated account;  
querying a management computer having information on the designated account to accept or deny use of the alternate account; and  
crediting the portable electronic device based on the querying step (col. 13, line 66-col. 15, line 10).

***Allowable Subject Matter***

10. Claims 1-10, 13-19, 25, 26, and 28 are allowable over prior art.

11. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach or fairly suggest either alone or in combination thereof, an electronic money system comprising:

an electronic money terminal having withdrawing for withdrawing a transaction amount from electronic money representing monetary value stored in a portable electronic device, and a

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manner of processing for calculating a balance due when the transaction amount exceeds an amount stored in the portable electronic device;

alternate account reading for reading account information for an alternate account at the electronic money terminal;

alternate account querying for querying a management computer having information on the alternate account for accepting or denying use of the alternate account to credit the portable electronic device; and

alternate account crediting for crediting the portable electronic device to the alternate account querying.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamara A. Franklin whose telephone number is (571) 272-2389. The examiner can normally be reached on Monday through Friday 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jamara A. Franklin  
Examiner  
Art Unit 2876

JAF  
April 02, 2007